

## REMARKS

In the foregoing amendments, claims 1 and 2 were amended. These amendments will be discussed below in conjunction with the rejection of the claims under 35 U.S.C. § 112, second paragraph.

Claims 1-4 are in the application for consideration by the examiner. Claims 1 and 2 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent No. 6,212,217 of Erie *et al.* (Erie). Claims 3 and 4 were not rejected over prior art.

The certified copy of the priority document, Japanese Patent Application No. 11-010652 filed on January 19, 1999, was filed in this application. Together with this response, applicant is submitting a Declaration of Mr. Takenori Suzuki, who is well acquainted with the English and Japanese languages, and who explains that the present application is identical with the Japanese Patent Application No. 11-010652, with the exception of some editorial matters that are explained in the declaration. In other words, the attached declaration establishes that the present application is a verified translation of the priority document. Therefore, the present application must be afforded the effective filing date of the priority document, namely, January 19, 1999, under the provisions of 35 U.S.C. §119.

The Official action included a discussion about the prior art rejection on pages 2 and 4 thereof. The portions of U.S. patent No. 6,212,217 of Erie discussed by the examiner were not present in the parent applications of Erie. Therefore, the filing date of the parent applications of Erie cannot be used as

the effective filing date of Erie for the portions of Erie not disclosed in the parent applications. For these reasons, applicant respectfully submits that the portions of the teachings of Erie relied upon in the Official action cannot support a prior art rejection of applicant's claims under 35 U.S.C. § 102(e).

Viewing the related U.S. application data of Erie, it can be seen that there are at least three patents in this family history. Erie relates to U.S. patent No. 6,212,217, which is based on an application filed September 3, 1999. This application was a continuation-in-part (CIP) of an application that resulted in U.S. patent No. 6,094,448 filed on February 11, 1999, which was a CIP of U.S. serial No. 08/886,715, filed July 1, 1997, which resulted in U.S. patent No. 5,970,082. The relationships between these patents, as well as the relationship between the filing dates of these patents and the present application, are shown in the following table:

U.S. Patent No.	U.S. Serial No.	Filing Date	Contains Figures 1 and 2 and discussion of stepped motors as in Erie patent
6,212,217 (Erie)	09/390,579	09/03/1999	YES
which was a continuation in part (CIP) of			
6,094,448	09/248,466	02/11/1999	NO
which was a continuation in part (CIP) of			
5,970,082	08/886,715	07/01/1997	NO
This application	09/484,424	01/18/2000	NA
Priority Japanese application	10652/1999	01/19/1999	NA

The two more recent patents (6,212,217 and 6,094,448) have a U.S. filing date that is after the effective filing date of the present application based on Japanese 11-010652 filed January 19, 1999. Therefore, any subject matter in these patents that is new to the disclosure of the U.S. patent No. 5,970,082 cannot be used against applicant's claims in the rejection under 35 U.S.C. §102(e), because the new subject matter has an effective filing date after the effective filing date of the present application.

All the disclosures from the Erie patent used in the rejection of applicant's claims under 35 U.S.C. §102(e) relate to subject matter that is new to the disclosure of U.S. patent No. 5,970,082. This new subject matter includes the discussion of a stepped motor in Erie on pages 2 the Official action and the reference to Figure 2 on page 4 of the Official action.

Only U.S. patent No. 5,970,082 has a filing date prior to the effective filing date of the the present application. Therefore, only the disclosure in this patent can be used to reject applicant's claims in a rejection under 35 U.S.C. §102(e). For this reason, it is only appropriate to view the teachings of U.S. patent No. 5,970,082 for determining prior art to applicant's claims invention. There is no need to view either Erie or U.S. patent No. 6,094,448, because any additional information in these patents in addition to that disclosed in U.S. patent No. 5,970,082 cannot be used reject applicant's claims.

The teachings of U.S. patent No. 5,970,082 (of Ershov) do not disclose or suggest the invention as set forth in the present claims within the meaning of 35 U.S.C. §102 or 35 U.S.C. §103. In the bending mechanism of the presently

claimed invention, such as shown in Fig. 1, a curvature of the grating 1 is adjusted by the movement of the pushing member 2 that is moved by the adjusting bolt. Normally, the curvature of the grating 1 is held constant in the situation where the adjustment is not performed by the adjusting bolt 5. In such a situation, if the bending mechanism receives a mechanical shock from an outside source, the adjusting bolt 5 or the pushing member 2 may be jarred out of their adjusted positions, which changes the curvature of the grating.

In the presently claimed invention, the pushing member 2 can be locked by locking screws 8, 11. The adjusting bolt 5 can be locked by a locknut, etc. By use of the presently claimed locking means, any undesired movement of the adjustment of the curvature is impossible, when it is locked by the locking means. In addition, any movement of the pushing member 2 and the adjusting bolts by the mechanical shocks is also prevented, when the locking means is locked.

The teachings of Ershov do not contemplate or suggest these structures in applicant's claims. Applicant's claim 1 specifically requires that the locking means and the bending mechanism are separate structures. Applicant's claim 2 defines separate locking means and adjustment means. The teachings of Ershov simply do not contemplate or suggest a separate locking means as required in the present claims. Therefore, the teachings of Ershov cannot suggest the separate locking means of applicant's claims.

On page 3, the Official action set forth a rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which applicant regards as the invention. The Official action stated that claims 1 and 2 are incomplete for omitting essential elements, such essential elements amounting to a gap between the elements. The Official action stated that the omitted element is the optical resonator and cited MPEP § 2172.01 in support of this position.

Applicant respectfully submits that the portion of the rejection citing MPEP § 2172.01 is not appropriate. The examiner is misreading the MPEP, because it is not necessary that all of the elements of the device be included in the claims. Otherwise, claims would become manufacturing specifications. The undersigned has never seen this type of rejection by examiners in other areas of the Patent Office. However, in order to expedite the allowance of this application, the preamble of claims 1 and 2 was amended in the foregoing amendments to define: “An optical resonator including an apparatus.” Elsewhere in claims 1 and 2, the expression “an optical resonator” was changed to --the optical resonator--.

The Official action continued that applicant has created a confusing claim by claiming that the adjustment of the curvature of the wavelength selection element is impossible. While the applicant does not agree with this position, claim 1 was amended above by adding --when the bending mechanism is locked by the locking means-- after the last appearing “impossible.” Along these lines, in claim 2, near the end of the claim, after the last appearance of “element,” --only-- was added.

The Official action stated that it is not clear in claim 2 if the bending mechanism and the adjustment mechanism are the system, since both provide adjustment to the curvature. Applicant respectfully submits that the claims clearly define that the bending mechanism adjusts the curvature, and the adjustment means acts on the bending mechanism causing it to adjust the curvature.


Applicant respectfully submits that claims 1-4 particularly point out and distinctly claim the subject matter which applicant regards as the invention within the meaning of 35 U.S.C. § 112, second paragraph. Therefore, applicant respectfully requests that the examiner reconsider and withdrawal this rejection.

It is respectfully noted that claims 3 and 4 were not rejected over prior art. The teachings of the cited references do not contemplate or suggest that the locking means is a locking screw, as set forth in these claims. Therefore, these claims are free of the prior art and a formal allowance of these claims is respectfully requested.

The foregoing is believed to be a complete and proper response to the Official action mailed July 21, 2003. While it is believed that all the claims in this application are in condition for allowance, should the examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolve any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which become due, may be charged to our deposit account No. 22-0256.

Respectfully submitted,  
VARNDELL & VARNDELL, PLLC

  
R. Eugene Varndell, Jr.  
Attorney for Applicants  
Registration No. 29,728

Atty. Case No. VX002067  
106-A S. Columbus St.  
Alexandria, VA 22314  
(703) 683-9730

\\V:\VDOCS\W\_DOCS\NOV03\P052-2067 RS.DOC